

### **Remarks**

The Office Action and the references cited therein have been carefully reviewed. The following remarks herein are considered to be responsive thereto. Claims 1-5 and 7-34 remain in this application. Claims 1, 12, 23 and 34 are presently amended by this amendment.

The Examiner rejected claims 1-14, 17-20 and 22-34 under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 6,519,607 issued to Mahoney, et al. (Mahoney) in view of US Patent No. 6,373,047 issued to Adan, et al. (Adan).

In response to the Examiner's rejections, Applicants have amended independent claims 1, 23 and 34. Applicants respectfully submit that independent claims 1, 23 and 34 are patentably distinguished over the cited references and are allowable and that claims 2-5 and 7-34 are allowable at least because they depend from an allowable base claim.

The patent to Mahoney discloses a method for controlling a computing device. The method performs the steps of capturing an image and electronically comparing the captured image to at least one stored image having a command associated therewith. Further, the method determines if there is a match to the image within a predetermined threshold, and if there is the method executes the associated command.

The patent to Adan discloses an input device for providing position information to a computer system based on movement of the input device. The computer input device accomplishes its objective by detecting images on a surface. The computer input device generates input information that is indicative of a change event when the device switches from reading one predetermined pattern to reading another predetermined pattern on a surface area.

In particular, independent claims 1, 23 and 34 of the present invention are being amended to include the limitation of cancelled dependent claim 6 for clarification purposes to more accurately and definitively set forth the invention. The claims have been amended to set forth in regard to claims 1, 23 and 34 the present invention comprises “comparing said resulting digital image to a pre-stored digital image of said user, wherein said comparing utilizes a filter to improve comparing of the resulting image with the pre-stored image.”

In the Examiner’s rejection of dependent claim 6, the Examiner states “Adan further teaches the method wherein said comparing step utilizes an approximation filter to improve comparing of the resulting image with pre-stored image (column 4, lines 1-10). Applicants respectfully direct the Examiner to the cited column 4, lines 1-10 of Adan wherein it states:

FIG. 1 and the related discussion are intended to provide a brief, general description of a suitable computing environment in which the invention may be implemented. Although not required, the invention will be described, at least in part, in the general context of computer-executable instructions, such as program modules, being executed by a personal computer or other computing device. Generally, program modules include routine programs, objects...

As presently cited, the Applicants contend that Adan does not disclose comparing said resulting digital image to a pre-stored digital image of said user, wherein said comparing utilizes a filter to improve comparing of the resulting image with the pre-stored image.

Further, It can be properly ascertained from the disclosure that while Mahoney discloses an image driven operating system, Adan is primarily discloses an input device that provides position information to a computer system based upon the movements of the input device (*See* col. 1, lines 26-29). One cannot determine that there is proper

motivation to combine the image driven operating system of Mahoney with the input device that provides position information to a computer system based upon the movements of the input device of Adan in order to arrive at the disclosure of the presently claimed invention.

The Federal Circuit has dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a):

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis.

*In re Dembiczak*, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them. In this instance the Examiner has not done this.

Thus, Applicants respectfully submit that the Examiner has used impermissible hindsight to reject claims 1-5 and 7-34 under 35 U.S.C. 103(a). To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

In light of the Examiner's lack of specificity with regard to the motivation to combine the cited references, the applicant respectfully submits that the rejections for obviousness of claims 1, 23 and 34 under 35 U.S.C. 103(a) lack the requisite motivation and must be withdrawn. Further, Applicants respectfully submit that independent claims 1, 23 and 34 are patentably distinguished over the cited references and are allowable and that claims 2-5 and 7-34 are allowable at least because they depend from an allowable base claim.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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